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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/252,574 02/18/99 WALKER

J 3553-4018

EXAMINER

TM02/1025

MORGAN & FINNEGAN LLP  
345 PARK AVENUE  
NEW YORK NY 10154

ROSEN, N

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

10/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

*[Handwritten signature]*

# Office Action Summary

Application No.

09/252,574

Applicant(s)

WALKER ET AL.

Examiner

Nicholas D. Rosen

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-25 and 29-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-25 and 29-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16. 6) ☐ Other: \_\_\_\_\_

Claims 2-25 and 29-43 have been examined.

***Prosecution Reopened***

Prosecution on the merits of this application is reopened on claims 2-25, and 29-43, considered unpatentable for the reasons indicated below, in the rejections under 35 U.S.C. 103.

Applicant is advised that the Notice of Allowance mailed July 27, 2001 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a Deposit Account.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 2165

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 2-8, 11, and 13-16**

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley in view of Abel et al. (5,289,371). Hensley discloses an allocation method in a buyer-driven system. Hensley does not expressly disclose identifying one of at least two sellers as a priority seller, but by beginning with a particular seller, while knowing that there was another shop down the street (second page, fourth, fifth, and ninth paragraphs), Hensley implicitly identified that seller as a priority seller. Hensley discloses providing the priority seller with a first look opportunity to satisfy a conditional purchase offer (first page).

Hensley does not expressly disclose determining which of at least two sellers can satisfy a conditional purchase offer before identifying one as a priority seller, but does disclose determining that one seller could satisfy a conditional purchase offer (by seeing the desired product in his shop, first page). Abel teaches sending floral orders to a plurality of florists, not druggists or auto mechanics, but persons or firms whose participation in the flower business has given evidence of their ability to satisfy an order to deliver flowers (column 11, lines 16-41). Hence, it would have been obvious to one

of ordinary skill in the art of commerce at the time of applicant's invention to determine which of at least two sellers could satisfy a conditional purchase offer before identifying one as a priority seller, for the obvious advantage of saving time, effort, and the disclosure of information which one might wish to keep confidential by making offers to persons or firms unable to satisfy the offers.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above. Hensley does not expressly disclose that he provided another of at least two sellers with a second look opportunity to satisfy the conditional purchase offer, but does state that it would have been possible to do so, and that this was widely known (second page, paragraphs, four, five, and nine). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to provide another of the at least two sellers with a second look opportunity to satisfy the conditional purchase offer, for the obvious advantage of giving the buyer another chance to obtain something that the priority seller was unable or unwilling to sell at a price acceptable to the buyer.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above, and further in view of Donner et al. (European Patent Application 0 512 702 A2). Hensley does not expressly disclose binding the buyer to the conditional purchase offer, but Donner et al. disclose this (page 3, lines 2-8). (See also page 6, lines 3-18, for more on conditional purchase offers in Donner et al.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to bind the buyer to the conditional purchase offer, for

the obvious advantage of assuring the seller that responding to the conditional purchase offer would be worth his time and trouble.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above. Hensley discloses notifying the buyer that the conditional purchase offer will not be satisfied (by a head shake, first page; admittedly the notification was withdrawn, but the buyer was nonetheless notified).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above, and further in view of Donner et al. Hensley does not disclose that one of the at least two sellers is an agency-based seller, but Donner et al. teach that sellers can be agency-based sellers (page 3, lines 2-8). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to have a seller be an agency-based seller, for the obvious advantage of enabling business to be conducted without the need to contact the seller.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abe as applied to claim 5 above. Hensley discloses that the seller was a broadcast-based seller (pages 1 and 2).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above, and further in view of Donner et al. Hensley does not expressly disclose that the conditional purchase offer is a binding conditional purchase offer, but Donner et al. teach this (page 3, lines 2-8). (See also page 6, lines 3-18, for more on conditional purchase offers in Donner et al.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's

Art Unit: 2165

invention to make the conditional purchase offer a binding conditional purchase offer, for the obvious advantage of assuring the seller that responding to the conditional purchase offer would be worth his time and trouble.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above. Hensley does not disclose assigning a random number to each of the at least two sellers, and using the random number to identify the priority seller. However, official notice is taken that it is well known to assign random numbers to decide who shall have priority. (The Selective Service system used until 1973 is one example. Drawing straws, rolling dice, cutting cards, etc., to decide who shall enjoy some privilege or perform some task are other examples.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to assign and use random numbers to identify the priority seller, for the obvious advantages of assuring potential sellers that they would have an equal chance at getting business, and to assure potential buyers that they would have equal chances of being assigned any potential seller as a priority seller, rather than, for example, being steered to a high-priced seller in collaboration with the operator of the system.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above, and further in view of Donner et al. Hensley does not expressly determining a buyer preference metric for each of the at least two sellers, and using the buyer preference metric to identify at least one of the at least two sellers as the priority seller, but Donner et al. teach doing so (page 9, line 16, through page 10,

Art Unit: 2165

line 41). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to determine and use a buyer preference metric, for the obvious advantage of steering the buyer to a seller who best matches the buyer's wants.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above. Hensley discloses providing an advantage to the one of at least two sellers identified as the priority seller, namely that the priority seller had the opportunity to make a profit on the sale of a pair of sandals to the buyer, an opportunity which other sellers did not have.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above. Hensley does not disclose determining whether more than one seller price will satisfy the conditional purchase offer, and selecting the highest seller price. However, official notice is taken that it is well known for sellers to prefer to sell higher-priced goods and services if possible, and to steer potential buyers toward higher-priced goods, which are typically shown first. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to determine whether more than one seller price would satisfy a conditional purchase offer, and to select the highest seller price, for the obvious advantages of enjoying the greater profits typically resulting from the sale of higher-priced goods and services, and leaving the lower-priced goods and services available for sale to customers only willing or able to pay a lower price.



Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 5 above. Hensley discloses that he started off to determine whether there were other sellers that could satisfy the conditional purchase offer, and to perform a low price search of the other sellers, before this was rendered unnecessary by the priority seller's decision to satisfy the conditional purchase offer.

#### **Claim 9**

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley in view of Abel et al. (5,289,371). Hensley does not expressly disclose identifying one of at least two sellers as a priority seller, but by beginning with a particular seller, while knowing that there was another shop down the street (second page, ninth paragraph), Hensley implicitly identified that seller as a priority seller. Hensley discloses providing the priority seller with a first look opportunity to satisfy a conditional purchase offer (first page). Hensley does not disclose that identifying one of at least two sellers as a priority seller includes: determining a number of first look opportunities due to the at least two sellers based on an adjusted market share, determining a number of first look opportunities given to the at least two sellers, and identifying one of the at least two sellers with the largest deficiency between percentage of first look opportunities given and opportunities due as the priority seller. However, Abel teaches identifying one of at least two sellers as a priority seller on by determining a number of opportunities due to at least two sellers (the number of opportunities due being implicitly derived from the percentage of opportunities due), determining a number of opportunities given to the at

Art Unit: 2165

least two sellers, and identifying one of the at least two sellers with the largest deficiency between opportunities given and opportunities due as the priority seller (column 11, lines 16-41). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to identify a priority seller on the basis of opportunities given and opportunities due as claimed, for the obvious advantage of assuring that first look opportunities are allocated in a fair and objective manner.

#### **Claim 10**

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley in view of Abel et al. (5,289,371). Hensley does not expressly disclose identifying one of at least two sellers as a priority seller, but by beginning with a particular seller, while knowing that there was another shop down the street (second page, ninth paragraph), Hensley implicitly identified that seller as a priority seller. Hensley discloses providing the priority seller with a first look opportunity to satisfy a conditional purchase offer (first page). Hensley does not disclose that identifying one of at least two sellers as a priority seller includes: determining a percentage of first look opportunities due to the at least two sellers based on an adjusted market share, determining a percentage of first look opportunities given to the at least two sellers, and identifying one of the at least two sellers with the largest deficiency between percentage of first look opportunities given and opportunities due as the priority seller. However, Abel teaches identifying one of at least two sellers as a priority seller on just these grounds (column 11, lines 16-41).

Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to identify a priority seller on the basis of market share as claimed, for the obvious advantage of assuring that first look opportunities are allocated in a fair and objective manner.

### **Claim 12**

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley in view of Abel et al. (5,289,371). Hensley discloses an allocation method in a buyer-driven system, comprising identifying one of at least two sellers as a priority seller; and providing the priority seller with a first look opportunity to satisfy a conditional purchase offer (page 1). Hensley does not disclose determining a market share for each of the at least two sellers, but Abel teaches doing so, and also teaches identifying one of the sellers that could satisfy a purchase offer as the priority seller based on that seller having the largest market share (column 11, lines 16-41, especially lines 38-40). It may also be noted that potential customers sometimes choose to take their business first to the most prominent firm, or firm with the largest market share, typically on the presumption that its products must be good to have won the largest market share, "Nothing succeeds like success." Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to identify one of the sellers having the largest market share that could also satisfy the conditional purchase offer as the priority seller, for the obvious advantages of dealing with a seller likely to provide quality goods or services at affordable prices, and saving time by giving the first

look opportunity to the firm most likely to have the appropriate product or service in its inventory or equivalent.

### **Claims 17-25**

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley in view of Abel et al. (5,289,371). Hensley discloses an allocation method in a buyer-driven system. Hensley discloses identifying a first look opportunity seller with a first look opportunity to satisfy a conditional purchase offer (first page); and identifying another of the sellers that can satisfy the conditional purchase offer as a second look opportunity seller (second page, ninth paragraph, beginning "Each participant knows"; see also first page, tenth paragraph, beginning "I don't know"). Hensley does not disclose identifying one of the sellers that can satisfy the conditional purchase offer as a first look opportunity seller based on relative market share in a relevant market and number of first look opportunities provided as compared to number of first look opportunities due, but Abel teaches identifying one of the sellers that can satisfy an offer as a first look opportunity seller based on relative market share in a relevant market and number of first look opportunities as compared to number of first look opportunities due (column 11, lines 16-41). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to identify one of the sellers as a first look opportunity seller as claimed, for the obvious advantage of allocating first look opportunities in a fair and objective manner.

Hensley does not expressly disclose determining which of a plurality of sellers can satisfy a conditional purchase offer, but does disclose determining that one seller could satisfy a conditional purchase offer (by seeing the desired product in his shop, first page). Abel teaches sending floral orders to a plurality of florists, not druggists or auto mechanics, but persons or firms whose participation in the flower business has given evidence of their ability to satisfy an order to deliver flowers (column 11, lines 16-41). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to determine which of a plurality of sellers could satisfy a conditional purchase offer, for the obvious advantage of saving time, effort, and the disclosure of information which one might wish to keep confidential by making offers to persons or firms unable to satisfy the offers.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 17 above. Hensley does not expressly disclose that he provided another of at least two sellers with a second look opportunity to satisfy the conditional purchase offer, but does state that it would have been possible to do so, and that this was widely known (second page, paragraphs, four, five, and nine). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to provide another of the at least two sellers with a second look opportunity to satisfy the conditional purchase offer, for the obvious advantage of giving the buyer another chance to obtain something that the priority seller was unable or unwilling to sell at a price acceptable to the buyer.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 17 above. Hensley does not disclose determining whether more than one seller price will satisfy the conditional purchase offer, and selecting the highest seller price. However, official notice is taken that it is well known for sellers to prefer to sell higher-priced goods and services if possible, and to steer potential buyers toward higher-priced goods, which are typically shown first. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to determine whether more than one seller price would satisfy a conditional purchase offer, and to select the highest seller price, for the obvious advantages of enjoying the greater profits typically resulting from the sale of higher-priced goods and services, and leaving the lower-priced goods and services available for sale to customers only willing or able to pay a lower price.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 17 above. Hensley discloses that he started off to determine whether there were other sellers that could satisfy the conditional purchase offer, and to perform a low price search of the other sellers, before this was rendered unnecessary by the priority seller's decision to satisfy the conditional purchase offer.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 17 above. Hensley does not disclose that the relevant market is an origin/destination pair, but official notice is taken that it is well known for markets to involve origin/destination pairs, e.g., the market for airplane tickets. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of

applicant's invention to apply the allocation method to an origin/destination pair, for the obvious advantage of obtaining bargains on tickets.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 17 above. Hensley discloses providing an advantage to the one of at least two sellers identified as the priority seller, namely that the priority seller had the opportunity to make a profit on the sale of a pair of sandals to the buyer, an opportunity which other sellers did not have.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 17 above, and further in view of Donner et al. (European Patent Application 0 512 702 A2). Hensley does not disclose that one of the at least two sellers is an agency-based seller, but Donner et al. teach that sellers can be agency-based sellers (page 3, lines 2-8). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to have a seller be an agency-based seller, for the obvious advantage of enabling business to be conducted without the need to contact the seller.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 17 above. Hensley discloses that the seller was a broadcast-based seller. Hensley discloses that the seller was a broadcast-based seller (pages 1 and 2).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley and Abel as applied to claim 17 above, and further in view of Donner et al. (European Patent Application 0 512 702 A2). Hensley does not expressly disclose binding the

buyer to the conditional purchase offer, but Donner et al. disclose this (page 3, lines 2-8). (See also page 6, lines 3-18, for more on conditional purchase offers in Donner et al.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to bind the buyer to the conditional purchase offer, for the obvious advantage of assuring the seller that responding to the conditional purchase offer would be worth his time and trouble.

#### **Claims 29-43**

Claim 32 is parallel to claim 5, and dependent claims 29, 30, 31, 33, 34, 35, 38, 40, 41, 42, and 43 are parallel to claims 2, 3, 4, 6, 7, 8, 11, 13, 14, 15, and 16, respectively, and are therefore rejected on the same grounds.

Claim 36 is parallel to claim 9, and therefore rejected on the same grounds.

Claim 37 is parallel to claim 10, and therefore rejected on the same grounds.

Claim 39 is parallel to claim 12, and therefore rejected on the same grounds.

#### ***Conclusion***

The examiner wishes to state for the record that he has considered the prior art listed on the Information Disclosure Statement mailed August 21, 2001, document #16 in the present case, and also that the prior art document listed there are identical to those previously listed in document #10, received April 2, 2001; the applicant's representatives have informed the examiner that confirmation of examiner having considered the art listed in document #10 was not received by applicant.



Art Unit: 2165

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30-5:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached at 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*Nicholas D. Rosen*  
Nicholas D. Rosen  
October 12, 2001

*Wynn Coggins*  
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